UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,904	02/26/2004	James J. Enright	ENRIGHT 21.016 (101353-00	4538

26304	7590	02/28/2005

KATTEN MUCHIN ZAVIS ROSENMAN
575 MADISON AVENUE
NEW YORK, NY 10022-2585

EXAMINER
THAI, CANG G

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Office Action Summary	Application No.	Applicant(s)
		10/788,904	ENRIGHT, JAMES J.
		Examiner	Art Unit
		Cang G. Thai	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *February 26, 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
  closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-37* is/are pending in the application.

  4a) Of the above claim(s) *1-12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All   b)☐ Some * c)☐ None of:

  1.☐ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____.

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
    application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
  Paper No(s)/Mail Date *February 26, 2004*.

4) ☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1.   This application discloses and claims only subject matter disclosed in prior

Application No. 10/293,405, filed November 13, 2002, and names an inventor or

inventors named in the prior application. Accordingly, this application may constitute a

continuation or division. Should applicant desire to obtain the benefit of the filing date of

the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Information Disclosure Statement

2.   The information disclosure statement (IDS) submitted on February 26, 2004 is in

compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is

considering the information disclosure statement.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

4.   Claims 13-37 are rejected under 35 USC 101 because the claimed invention is

directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

1.   Whether the invention is within the technological arts; and

2.   Whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract ideas, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, use or advance the technological arts.

In the present cases, Claims 13 and 31, respectively, do not require any technology. The recited steps of selecting one or more postal objects does not apply, involve, use, or advance the technological arts since all of the recited steps can be done with no technology at all. The recited steps only constitute an idea of how to select one or more postal objects form a plurality of postal objects for customers.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful (specific utility), concrete (repeatability and/or implementation without undue experimentation), and tangible (a real or actual affect) result.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6.   Claims 13-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7.   Claim <u>13</u> recites the limitations of phases "determining an access charge for each object" and "gross profit from the customer" are not clear expressed. It is not clear on the gross profit because there is summing step to calculate the gross profit. The preamble mentions the term "determining", which normally means "to find out or come to a decision about by investigation, reasoning, or calculation", but there is no step for weighing the object in order to perform the calculation of the object cost. The preamble also mentions the term "charge", which normally means "the quantity of load or weight", but there is no step for weighing the object. Term "return on investment from the customer" is not clear, because there is no step mention storage previous information to compare to in order to determine the return investment.

8.   Claim 23 needs additional clarification for "assembled by offline processing (are single objects assembled offline into anything but packets?)"

9.   Claim 29 needs clarification. The preamble mentions the term "online", which normally means "connected to, served by, or available through a system and especially a computer or telecommunications system (database)", but there is no step for a computer or telecommunication system (database) for the online processing.

10.   Claim 28 needs clarification for "not sure whether this is treated in the specification, if so, let's write as an additional dependent claim".

Claim Rejections - 35 USC § 102

11.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12.   The Applicant submitted Preliminary Amendment on February 26, 2004 to cancel claims 1-12, and added new claims 13-37. No new matter is added.

13.   Claim 13-37 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,797,830 (BAGGARLY ET AL.).

As for claim 13, BAGGARLY discloses a method for selecting one or more postal objects from a plurality of postal objects for assembly in a plurality of mail packages, each mail package being directed to one of a plurality of customers, the method comprising the steps of:

identifying the plurality of customers {Column 1, Lines 52-53, wherein this reads over "the sender may send certain general interest enclosures to all customers"};

identifying the plurality of objects {Column 1, Lines 54-55, wherein this reads over "enclosing one or more of many special interest enclosures to select or targeted customers"};

determining an access charge for each object by customer, which access charge is determined as a function of an expected gross profit from the customer, a probability of success of the object with respect to the customer, and provisioning costs for the object, such that an expected return on investment from the customer for an object is substantially the same for each of the plurality of customers {Column 2, Lines 9-11, wherein this reads over "accurate determination of the weight of an envelope and its associated required inserts, results in a substantial financial savings"}.

As for claim 14, BAGGARLY discloses the method of claim 13, further

comprising the step of:

selecting one or more objects from the plurality of objects to be assembled into

one of the plurality of mail packages, such that an expected value for the mail package

is maximized {Column 2, Lines 13-15, wherein this reads over "an inserter machine

which is easily operated for determining the accurate weight of the envelope and its

associated required contents"}.

As for claim 15, BAGGARLY discloses the method of claim 14, wherein the

expected value for the mail package is a function of the access charge for each

selected object and the provisioning costs, and object selection is subject to one or

more predetermined constraints {Column 2, Lines 22-26, wherein this reads over

"inserter machine which includes the maximum possible number of the optional

advertising inserts for stuffing with a customer's envelope without increasing the

postage amount required by the stuffed envelope"}.

As for claim 16, BAGGARLY discloses the method of claim 15, wherein each

object has an object type selected from the group consisting of outgoing envelopes,

primary documents, return envelopes, and inserts {Column 9, Lines 39-43, wherein this

reads over "telephone billing documents, for example, in the manner afore described,

the data processor 102 must be supplied with information relative to the per document

weight of the documents at each of the stations 31, 32, 33, 34, 35, 36, 37, and 42}.

As for claim 17, BAGGARLY discloses the method of claim 16, wherein the one

or more predetermined constraints include at least one of a weight constraint and a

number of objects constraint for each mail package {Column 6, Lines 6-8, wherein this reads over "first postage meter 84 is preset to apply appropriate postage to a stuffed envelope weighing in the range from 1.00 ounces to 1.99 ounces"}.

As for claim 18, BAGGARLY discloses the method of claim 17, wherein the number of objects constraint specifies at least one of a minimum number of objects constraint {Fig. 1, Element 88} and a maximum number of objects constraint for each of one or more of the object types {Fig. 1, Element 62}.

As for claim 19, BAGGARLY discloses the method of claim 15, wherein object selection is also determined as a function of managerial prerogatives {Column 3, Lines 63, wherein this reads over "on mode (the "select" mode) the first document feed from the station 31 with respect to each customer functions as a control document which to extent governs downstream operations"}.

As for claim 20, BAGGARLY discloses the method of claim 19, wherein the managerial prerogatives may specify a status by customer for each selectable object, which specified status includes one of "do not use", "absolute priority", "high priority" and "normal priority" {Column 1-2, Lines 68 & 1-2, wherein this reads over "the general interest and special interest informational enclosures, are high priority "required" items for inclusion in a customer's envelope"}.

As for claim 21, BAGGARLY discloses the method of claim 17, wherein the weight constraint is specified as a total weight of all objects included in the mail package {Column 2, Lines 16-18, wherein this reads over "an inserter machine which is easily

operated for determining the accurate weight of an envelope and its associated required contents"}.

As for claim 22, BAGGARLY discloses the method of claim 18, wherein ones of the one or more objects selected for each mail package are assembled into one or more object packets, and the mail package is assembled from at least one of the one or more object packets one or more of the plurality of objects {Column 2, Lines 41-47, wherein this reads over "third-party advertising documents are fed from one or more downstream insert stations if the indicia on the master control document so authorizes and if and only if the additional weight occasioned by the feeding of the advertising document s would not cause an increase in the package for the customer's stuffed envelopes"}

As for claim 23, BAGGARLY discloses the method of claim 22, wherein the one or more object packets and/or single objects are assembled by offline processing (are single objects assembled offline into anything but packets?). {Column 2, Lines 30-31, wherein this reads over "an insertion machine a first insert station feeds one or more sheets for a customer onto a conveyor"}.

As for claim 24, BAGGARLY discloses the method of claim 23, wherein the plurality of mail packages are assembled by online processing {Column 3, Lines 56-58, wherein this reads over "the documents fed by the feeder of station 31 during a given machine cycle are all associated with a particular customer"}.

As for claim 25, BAGGARLY discloses the method of claim 24, wherein the one or more object packets produced by offline processing are stored in a packet storage

device and retrieved for on-line processing {Column 9, Lines 39-43, wherein this reads

over "telephone billing documents, for example, in the manner afore described, the data

processor 102 must be supplied with information relative to the per document weight of

the documents at each of the stations 31, 32, 33, 34, 35, 36, 37, and 42"}.

As for claim 26, BAGGARLY discloses the method of claim 24, wherein the

storage and retrieval steps are performed by one or more packet retrieval transfer

devices {Column3, Lines 25-30, wherein this reads over "during successive machine

cycles a document on conveyor 20 travels in a leftward direction so that during the

machine cycle MC2 the document is proximate the station 32; in the machine cycle

MC3 the document is proximate the station 33, and so forth"}.

As for claim 27, BAGGARLY discloses the method of claim 15, wherein the

selection step is performed using goal integer programming {Column 17, Lines 29-32,

wherein this reads over "once programming of the insertion machine has been

accomplished using the program mode, and when documents are ready to be feed from

the feeder station 31, the insertion machine operation is ready to enter the calculation

mode"}. It appears this step also performed using the goal integer programming.

As for claim 28, BAGGARLY discloses the method of claim 15, wherein

provisioning costs include printing and ink (not sure whether this is treated in the

specification, if so, let's write as an additional dependent claim) costs {Column 29,Lines

3-8, wherein this reads over "the sender includes the advertising literature of the third

parties in appropriate envelopes mailed to the sender's customers if the inclusion of the

advertising literature does not increase the sender's postage cost for each customer"}.

It appears that the cost including printing and ink costs would be included in the advertising literature.

As for claim 29, BAGGARLY discloses the method of claim 18, wherein the one or more object types include inserts {Column 5, Lines 14-16, wherein this reads over "the sender has agreed to include one or both of the advertising inserts in stuffed envelopes for one of the sender's"}.

As for claim 30, BAGGARLY discloses the method of claim 19, wherein the selection step is performed using goal integer programming {Column 17, Lines 29-33, wherein this reads over "once programming of the insertion machine has been accomplished using the program mode, and when documents are ready to be fed from the feeder station 31, the insertion machine operation is ready to enter the calculation mode"}.

As for claim 31, BAGGARLY discloses a method of selecting objects from a plurality of objects to be provided to each of a plurality of customers, the method comprising the steps of:

identifying the plurality of customers {Column 1, Lines 52-53, wherein this reads over "the sender may send certain general interest enclosures to all customers"};

identifying the plurality of objects {Column 1, Lines 54-55, wherein this reads over "enclosing one or more of many special interest enclosures to select or targeted customers"};

determining an access charge for each object by customer, which access fee is variably determined {Column 2, Lines 9-11, wherein this reads over "accurate

determination of the weight of an envelope and its associated required inserts, results in a substantial financial savings"}. It appears that access fee is included in a a substantial financial savings.

As for claim 32, which has the same limitations as in claim 13, therefore it is rejected for the similar reason set forth in claim 13.

As for claim 33, which has the same limitations as in claim 14, therefore it is rejected for the similar reason set forth in claim 14.

As for claim 34, which has the same limitations as in claim 15, therefore it is rejected for the similar reason set forth in claim 15.

As for claim 35, BAGGARLY discloses the method of claim 34, wherein the plurality of objects includes sales offers for unsold airline seats {Column 5, Lines 29-32, wherein this reads over "the sender determines the number of advertising inserts fed on behalf of each third party and charges the third party a per insert fee for the sender's service"}. It appears that the number advertising inserts fed on behalf of each third part would also be the airline.

As for claim 36, BAGGARLY discloses the method of claim 34, wherein the plurality of objects includes sales offers for unsold shipping capacity {Column 5, Lines 29-32, wherein this reads over "the sender determines the number of advertising inserts fed on behalf of each third party and charges the third party a per insert fee for the sender's service"}. It appears that the number advertising inserts fed on behalf of each third part would also be the shipping.

As for claim 37, BAGGARLY discloses the method of claim 34, wherein the

plurality of objects includes sales offers to be provided in postal mail packages directed

to each of the plurality of customers {Columns 4-5, Lines 66-68 & 1-2, wherein this

reads over "the indicia 50 on control document 46 requires that the inserts from these

selected stations be included with the sheets comprising the customer's bill (fed from

station 31) and the billing card (fed from station 32) in the customer's stuffed envelope"}.

Conclusion

14.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

I.   U.S. Patent:

    1)   U.S. Patent No. 3,819,173 (ANDERSON ET AL.) is cited to teach a

        method and apparatus for producing different magazines composed of

        different predetermined combination of signatures for different subscribers

        in a continuous process,

    2)   U.S. Patent No. 5,684,706 (HARMAN ET AL.) is cited to teach a system

        for producing a mail pieces,

    3)   U.S. Patent No. 5,816,715 (HARMAN ET AL.) is cited to teach a system

        and method for buffering materials that are produced at tow different rates

        of speed, and

4)   U.S. Patent No. 4,384,196 (MCCUMBER ET AL.) is cited to teach a

system for attaching data cards to mailer forms including apparatus having

a supply of serially connected mailer forms.

II.   Foreign Patent:

1)   EP 0 805 421 A2 (THIEL, WOLFGANG DR) is cited to teach a method

and arrangement for processing data in a mail processing system with a

franking machine.

III.   Non-Patent Literature:

1)   John W. Sutherland, "A Quasi-Empirical Mapping of Optimal Scale of

Enterprise", October 1980, Management Science (pre-1986), Volume 26,

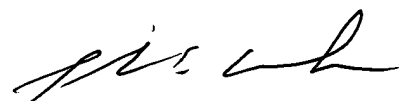No. 10, ABI/INFORM Global, Page 963.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cang (James) G. Thai whose telephone number is (703) 305-0553. The examiner can normally be reached on 6:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CGT
1-18-2005

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600